

**Examination for Registration to Practice in Patent Cases
Before the U.S. Patent and Trademark Office
April 12, 2000**

Morning Session Model Answers

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1. ANSWER: (A). 35 U.S.C. § 102. When a patent claims a composition in terms of ranges of element, any single prior art reference falling within each of the ranges anticipates the claim. *Atlas Powder Co. v. IRECO, Inc.*, 51 USPQ2d 1943 (Fed. Cir. 1999) (holding “[i]nherency is not necessarily coterminous with knowledge of those of ordinary skill in the art...Artisans of ordinary skill may not recognize the inherent characteristics or functioning of the prior art... . However, the discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art’s functioning, does not render the old composition new to the discoverer.” The court also held that “this same reasoning holds true when it is not a property, but an ingredient, which is inherently contained in the prior art.”). (B) is not the most correct answer because the prior art reference, to anticipate the claimed invention, is not required to recognize an inherent property. (C) is not the most correct answer because the prior art reference, to anticipate the claimed invention, is not required to recognize an inherent function of oxygen. (D) is not the most correct answer because the prior art reference, to anticipate the claimed invention, is not required to recognize an inherent ingredient, oxygen. (E) is not the most correct answer because (B), (C) and (D) are not correct, whereas (A) is correct.

2. ANSWER: (E) is the most correct answer. (A) and (C) can be corrected by a certificate of Correction. MPEP § 1481 [p. 1400-47]. (D) can be corrected by a Certificate of Correction. 37 C.F.R. § 1.324; MPEP § 1481 [p. 1400-44]. (B) is incorrect. Such a mistake, which affects the scope and meaning of the claims in a patent, is not considered to be of the “minor” character required for issuance of a Certificate of Correction. MPEP § 1481.

3. ANSWER: (E) is correct because (B) and (D) are correct. 37 C.F.R. § 1.75(c); MPEP § 608.01(n) [pp. 600-66,67]. (A) and (C) are incorrect. MPEP § 608.01(n) (“[A] multiple dependent claim may not serve as a basis for any other multiple dependent claim, either directly or indirectly”).

4. ANSWER: (C). *Moleculon Research Corp. v. CBS, Inc.*, 229 USPQ 805, 809 (Fed. Cir. 1986); MPEP § 2133.03(b). Although reexaminations are limited to prior art patents and printed publications, that limitation is not present in original prosecution. Thus (A) is incorrect. (B) and (D) are wrong because there is no requirement that on-sale activity be public. MPEP § 2133.03(b). (E) is wrong at least because an on-sale bar does not require an actual sale. A bar can also be based on an offer to sell.

5. ANSWER: (B). Answers (A) and (E) are incorrect because they improperly seek to broaden the parent claim. 37 C.F.R. 1.75(c). Answer (A) broadens the range by going below the

stated limit. Answer (E) broadens by trying to remove a member of the Markush group, and covering subject matter that is not covered by the parent claim. Answer (C) is incorrect because claim 1 uses the close ended claim term “consists” in connection with the second gas, which precludes the addition of further components to the second gas in claim 4. Answer (D) is incorrect because the use of the exemplary language “such as” is improper is improper under

35 U.S.C. § 112, second paragraph, and because it is inconsistent with claim 1. See MPEP § 2173.05(d).

6. ANSWER: (C). MPEP § 2113, page 2100-51, citing *In re Fessman*, 489 F.2d 742, 744, 180 USPQ 324, 326 (CCPA 1974). (A) and (E) are incorrect because “[t]he fact that it is necessary for an applicant to describe his product in product-by-process terms does not prevent him from presenting claims of varying scope.” MPEP § 2173.05(p), item (I). (D) is incorrect even if it is not necessary to describe the product in product-by-process form. (D) is incorrect because “determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art was made by a different process.” MPEP § 2113, [p.2100-51]. (B) is incorrect. “A claim to a device, apparatus, claim, or composition of matter may contain a reference to the process in which it is intended to be used...so long as it is clear that the claim is directed to the product and not the process.” MPEP § 2173.05(p), item (I) [p.2100-174].

7. ANSWER: (B). Answer (B) provides proper antecedent basis for “said mid-point” in part (iv) of Claim 1 and in Claim 2, and “said connector” in Claim 3. Answer (A) is incorrect at least because it does not provide antecedent basis for “said connector” in Claim 3. Answer (C) is narrower than Answer (B) because it includes the additional limitation of a reservoir and therefore does not “most broadly” complete claim 1. Answer (D) is incorrect because it does not provide proper antecedent basis for “said mid-point” in part (iv) of Claim 1 and in Claim 2. Answer (E) is incorrect because it does not provide antecedent basis for “said connector” in Claim 3.

8. ANSWER: (D). MPEP § 710.02(e), pages 700-82 and 83, under the heading “FINAL REJECTION – TIME FOR REPLY” states, “If an applicant initially replies within 2 months from the date of mailing of any final rejection setting a 3-month shortened statutory period for reply and the Office does not mail an advisory action until after the end of the 3-month shortened statutory period, the period for reply for purposes of determining the amount of any extension fee will be the date on which the Office mails the Advisory Action advising applicant of the status of the application...” Hence, since no extension fee was paid in the fact pattern, the time allowed applicant for reply to the action from which the appeal was taken is the mail date of the Advisory Action, i.e., May 31, 2000. 37 C.F.R. § 1.192(a) recites, in pertinent part, “Appellant must, within two months from the date of the notice of appeal under § 1.191 or within the time allowed for reply to the action from which the appeal was taken, if such time is later, file a brief in triplicate.” (A), (B), and (C) are wrong because they recite dates which are earlier than May 31, 2000, the last date for filing a Brief without an extension of time. (E) is wrong because it is after the last date for filing a Brief without an extension of time, and therefore an extension of time would be required.

9. ANSWER: (D). 37 C.F.R. § 1.111(b); MPEP §§ 818.03(a)-(c). (I) is incorrect since the traversal does not distinctly point out the supposed errors in the examiner’s action, and no election is made. 37 C.F.R. § 1.143. (II) is incorrect since the traversal does not distinctly point out the supposed errors in the examiner’s action. (III) is incorrect since no election is made. (E) is incorrect because (D) is correct.

10. ANSWER: (E). MPEP § 716.10. There is no requirement that a publication describe something that has actually been reduced to practice before the publication can act as a prior art reference. Thus, statement (A) is not correct. With regard to statement (B), there is no requirement under 35 U.S.C. § 102 that a publication be made with an inventor's knowledge or permission before it constitutes prior art. Statement (C) is incorrect at least because the Wing Cap was "described in a printed publication in...a foreign country" (35 U.S.C. § 102(a)) before Mario's filing date and is therefore presumptive prior art. (D) is incorrect because even if the promotional article constituted an offer to sell, it was not in this country and was made less than a year prior to Mario's filing date. 35 U.S.C. § 102(b).

11. ANSWER: (E). Mario may rely on activities in both Germany (a WTO member country) and Canada (a NAFTA country) in establishing a date of invention prior to publication of the Moose Jaw Monthly article or in establishing priority. 35 U.S.C. § 104; see also MPEP § 715.01(c).

12. ANSWER: (E). MPEP § 410 makes clear that the certification requirement set forth in 37 C.F.R. § 10.18(b) "has permitted the PTO to eliminate the separate verification requirement previously contained in 37 C.F.R. ...1.27 [small entity statements], ...1.52 [English translations of non-English documents], ...1.55 [claim for foreign priority], [and] ...1.102 [petition to make an application special]."

13. ANSWER: (A). 35 U.S.C. § 112, first paragraph. *Enzo Biochem, Inc. v. Calgene, Inc.*, 52 USPQ2d 1129 (Fed. Cir. 1999). As stated in MPEP § 2164.01, "The standard for determining whether the specification meets the enablement requirement was cast in the Supreme Court decision of *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916) which postured the question: is the experimentation needed to practice the invention undue or unreasonable? That standard is still the one to be applied. *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). Accordingly, even though the statute does not use the term 'undue experimentation,' it has been interpreted to require that the claimed invention be enabled so that any person skilled in the art can make and use the invention without undue experimentation." (B) is incorrect. As stated in MPEP 2107, part c. The requirement of 35 U.S.C. 101, for a "practical" utility or otherwise, is not a requirement that an applicant demonstrate that a utility is a safe or fully effective for human or animal consumption. *In re Brana*, 51 F.3d 1560, 34 USPQ2d 1436 (Fed. Cir. 1995). (C) is incorrect. The disclosure is inconsistent with published information. 35 U.S.C. § 112, first paragraph. (D) is incorrect. Enablement for the claims in a utility application is found in the specification preceding the claims, as opposed to being in the claims. The claims do not provide their own enablement. 35 U.S.C. § 112, first paragraph. (E) is incorrect. The lack of necessity to theorize or explain the failures does not alleviate the inventor from complying with 35 U.S.C. § 112, first paragraph by providing an enabling disclosure that is commensurate in scope with the claims.

14. ANSWER: (B). MPEP 715.04. (A) is incorrect since it cannot be shown that less than all the inventors invented the subject matter of claim 2. (C) and (D) are incorrect since the assignee can make an affidavit under 37 C.F.R. § 1.131, only when it is not possible to produce the affidavit of the inventor. The facts indicate that all inventors were readily available produce the affidavit. (E) is incorrect since (B) is correct.

15. ANSWER: All answers accepted.

16. ANSWER: (E) is the most correct answer. Claim 9, though broad, is supported by the specification. The minimum memory recited in the claim as original disclosure, is self-supporting. 35 U.S.C. § 112, first paragraph. Claim 10 is a proper dependent claim because it depends from and further restricts the scope of a preceding claim. 37 C.F.R. § 1.75(c). Claim 11 is an improper dependent claim because it expands upon, as opposed to further restricts, the scope of claim 10. Claim 10, depending on Claim 9, has a 1 gigabyte memory minimum, whereas Claim 11 expands upon the minimum memory by setting a lower minimum of ½ gigabyte.

17. ANSWER: (E) is correct because (B) and (C) are correct. (A) does not overcome the prior art because the broad “comprising” language permits the laminate to include additional layers, such as an adhesive layer. MPEP 2111.03. (B) overcomes a 35 U.S.C. § 102 rejection because the claim requires a light-sensitive layer to be in continuous and direct contact with the transparent protective layer, whereas the prior art interposes an adhesive layer between the light-sensitive layer and transparent protective layer. (C) also avoids the prior art by using a negative limitation to particularly point out and distinctly claim that Smith does not claim any laminate including an adhesive layer. MPEP 2173.05(i).

18. ANSWER: (D). Extending patent term is not a policy underlying any section of 35 U.S.C. § 102. Answers (A), (B), (C) and (E) do state policies underlying the public use bar. *Lough v. Brunswick Corp.*, 86 F.3d 1113, 39 USPQ2d 1100 (Fed. Cir. 1996).

19. ANSWER: (B). 37 C.F.R. § 1.83(a); MPEP §§ 608.02(d) and 706.03(o). Choices (A), (C), and (D) are incorrect. As stated in MPEP § 706.03(o), “If subject matter capable of illustration is originally claimed and it is not shown in the drawing, the claim is not rejected but applicant is required to add it to the drawing.” See MPEP § 608.01(l). (D) is incorrect because the reply is not timely. (E) is incorrect because (B) is correct.

20. ANSWER: (E) is correct and (A), (B), (C), and (D) are wrong because MPEP § 710.02(e), right column of page 700-83, recites, “[I]f applicant initially replies within 2 months from the date of mailing of a final rejection and the examiner mails an advisory action before the end of 3 months from the date of mailing of the final rejection, the shortened statutory period will expire at the end of 3 months from the date of mailing of the final rejection. In such a case, any extension fee would then be calculated from the end of the 3-month period.”

21. ANSWER: (B) is the most correct answer. 37 C.F.R. § 1.72(b); MPEP § 608.01(b).

22. ANSWER: (E). MPEP §§ 715 and 804.02. (II) is incorrect since a 37 C.F.R. § 1.131 affidavit cannot be used to overcome a rejection under 35 U.S.C. § 102(b). MPEP 715. (III) is incorrect since a 37 C.F.R. § 1.131 affidavit cannot be used to overcome a statutory double patenting rejection. MPEP § 804.02. Thus (B) and (C) are incorrect.

23. ANSWER: (C). The original mistake in omitting Tommie from the list of inventors was automatically corrected by filing the oath executed by both Jo and Tommie. 37 C.F.R.

§1.48(f)(1). Under 37 C.F.R. §1.48(b), a change in inventive entity is thereafter required upon cancellation of the non-elected claims. (B) is wrong because inventorship was automatically corrected with the filing of the correct oath. (A) is wrong because Tommie was properly named as a co-inventor in the parent application, and 35 U.S.C. §120 requires, *inter alia*, only one common inventor. (D) is incorrect because an assignee's written consent is not required if an inventor is being deleted because the prosecution of the application results in the cancellation of claims so that fewer than all of the currently named inventors are the actual inventors of the inventions being claimed in the application. 37 C.F.R. §1.48(b). (E) is incorrect because the divisional application never named Jo as an inventor so there is no need to correct the inventorship.

24. ANSWER: (E). Statement (A) is incorrect at least because the parent application, which included claim 20, was incorporated by reference. Therefore, adding claim 20 does not constitute the addition of new matter. Statement (B) is wrong because at least claim 20 is properly viewed as a joint invention ("Jo and Tommie collaborated to invent a method to clean-up toxic waste spills using the chemical made according to the unobvious technique invented by Jo"). MPEP §§ 605.07, item (E), and 2137.01. Under 35 U.S.C. § 116, inventors may apply for a patent jointly even if they did not make the same type or amount of contribution and did not each make a contribution to the subject matter of every claim of the patent. Statement (C) is wrong because 35 U.S.C. § 121 precludes such a rejection. Statement (D) is wrong at least because Tommie is entitled to the filing date of the parent application.

25. ANSWER: (E). (E) is correct because the patent does not become a statutory bar against the subject matter of claims 6-10 until the one year from the issuance of the patent. 35 U.S.C. § 102(b). As to (B) and (D), the deliberately cancelled claims cannot be recaptured by reissue. See *In re Watkinson*, 14 USPQ2d 1407 (Fed. Cir. 1990); and MPEP §§ 1412.02 and 1450. (A) is incorrect because (E) is correct. (C) is incorrect because there is no provision in 35 U.S.C. § 251 for filing a reissue application as a divisional application of an issued patent.

26. ANSWER: (C) is the most correct. *Corona v. Dovan* 273 U.S. 692, 1928 CD 252 (1928); MPEP 2138.05 (section styled "Requirements To Establish Actual Reduction To Practice"). (A) is incorrect. MPEP 2138.05, (section styled "Requirements To Establish Actual Reduction To Practice"). The same evidence sufficient to establish a constructive reduction to practice is not necessarily sufficient to establish actual reduction to practice, which requires a showing of the invention in a physical or tangible form containing every element of the count. *Wetmore v. Quick*, 536 F.2d 937, 942 190 USPQ 223 227 (CCPA 1976). (B) is incorrect. MPEP 2138.05 (section styled "Constructive Reduction To Practice Requires Compliance With 35 U.S.C. 112, First Paragraph"). *Kawai v. Metlesics*, 489 F.2d 880, 886, 178 USPQ 158, 163 (CCPA 1973). (D) is incorrect. *Keizer v. Bradley*, 270 F.2d 396, 397, 123 USPQ 215, 216 (CCPA 1959) (the diligence of 35 U.S.C. § 102(g) does not require "an inventor or his attorney to drop all other work and concentrate on the particular invention involved"); MPEP 2138.06. (E) is incorrect. The diligence of a practitioner in preparing and filing an application inures to the benefit of the inventor. See MPEP 2138.06 (section styled "Diligence Required In Preparing And Filing Patent Application"). *Haskell v. Coleburne*, 671 F.2d 1362, 213 USPQ 192,195 (CCPA 1982) (six days to execute and file application was acceptable).

27. ANSWER: (C). MPEP § 2111.02. (A), (B), and (D) are incorrect since the “use” recited in the preamble in Claim 1 does not result in a structural difference between the claimed invention and the disclosure in the Gold patent. *In re Casey*, 370 F.2d 576 (CCPA 1967). (A) is further incorrect since the reply would not be filed within the statutory period. (D) is further incorrect since the rejection is not under 35 U.S.C. § 103, and any “teaching away” in the Gold patent is not applicable to the rejection under 35 U.S.C. § 102(a). (E) is incorrect since evidence of commercial success, relevant to secondary considerations concerning rejections under 35 U.S.C. § 103, is not relevant to overcoming rejections under 35 U.S.C. § 102(a). (C) is correct since the amendment is timely filed, supported by the disclosure, and renders the rejection under 35 U.S.C. § 102(a) inapplicable.

28. ANSWER: (B) is the most correct answer. MPEP 2164.05(a). Statement (i) is true because a later dated publication cannot be used to enable an earlier dated application. Statement (ii) is true since an examiner can look to later dated art if the art discloses the state of the art at the time of the invention. Statement (iii) is false since enablement is judged at the date of filing and later dated references cannot be used to establish enablement.

29. ANSWER: (E) is correct because the express abandonment was the result of a deliberative, intentional course of action. MPEP 711.01. Thus, (A), (B), (C), and (D) are wrong. (A) is wrong because an express abandonment is effective if signed by the attorney or agent of record. 37 C.F.R. § 1.138. (B) is wrong because the express abandonment was filed, not as a mistake, but as the result of a deliberative, intentional course of action, i.e., after careful review of the Office action and the Williams patent, and discussions with XYZ officials. The arrival by you at a different conclusion after reviewing the same facts a second time is not a mistake of fact. *In re Maldague*, 10 USPQ2d 1477, 1478 (Comm’r Pat. 1988). (C) and (D) are wrong because MPEP § 711.03(c) recites, “An intentional abandonment of an application...precludes a finding of unavoidable or unintentional delay pursuant to 37 C.F.R. § 1.137. See *Maldague*, 10 USPQ2d at 1478.”

30. ANSWER: (C). MPEP § 2173.05(c), section III. (I) and (II) are incorrect since the phrase “an effective amount of voltage” has two different functions, i.e., to “protect windshield glass from cracking” and “for defrosting windshields.” A claim has been held to be indefinite when the claim, as in this case, fails to state which of two disclosed functions is to be achieved. Thus, choices (A), (B), and (D) are incorrect. (C) is correct, since the amended claim would state the function that is to be achieved. (E) is incorrect since (C) is correct.

31. ANSWER: (D) is the most correct answer. See MPEP 2143.01, section styled, “The Prior Art Must Suggest The Desirability Of The Claimed Invention”), which states, “Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).” (A) is incorrect because the location of the suggestion, teaching, or motivation to modify or combine the teachings is not limited to being found only in the references themselves. MPEP 2143.01. (B) is incorrect. See MPEP 2143.01, section styled “Fact That The Claimed Invention Is Within The Capabilities Of One Of Ordinary Skill In The

Art Is Not Sufficient By Itself To Establish *Prima Facie* Obviousness.” (C) is incorrect. See MPEP 2143.01, section styled “Fact That References Can Be Combined Or Modified Is Not Sufficient To Establish *Prima Facie* Obviousness.” (E) is incorrect inasmuch as (A), (B) and (C) are incorrect.

32. ANSWER: (B). See *Ex parte Mead Johnson & Co.*, 227 USPQ 78 (Bd. Pat. App. & Int. 1985); MPEP 716.02(a) page 700-155 (Absence of Expected Property is Evidence of Nonobviousness). (A) is incorrect. “Expected beneficial results are evidence of obviousness of the claimed invention.” *In re Gershon*, 372 F.2d 535, 538, 152 USPQ 602, 604 (CCPA 1967), MPEP 716.02(c). (C) is incorrect. Unexpected results must be commensurate in scope with the claimed invention. *In re Clemens*, 622 F.2d 1029, 1036, 206 USPQ 298, 296 (CCPA 1980); MPEP 716.02(d). (D) is incorrect. Evidence not showing that the unexpected properties of a claimed invention have a significance equal to or greater than the expected properties may be insufficient to rebut the evidence of obviousness. *In re Nolan*, 553 F.2d 1261, 1267, 193 USPQ 641, 645 (CCPA 1977); MPEP 716.02(c). (E) is incorrect because (A), (C) and (D) are incorrect.

33. ANSWER: (B). 35 U.S.C. § 154(c)(1). Except for circumstances that do not obtain from the given facts, the term of a patent that is in force or that results from an application filed before the date that is 6 months (June 8, 1995) after the date of the enactment of the Uruguay Round Agreements Act (January 8, 1995) shall be the greater of the 20-year term or 17 years from grant. The 20 year term is the “greater” term. As explained in MPEP 1309.01, all patents that will issue on an application that is filed before June 8, 1995, will automatically have a term that is the greater of the twenty year term, which begins on the date the patent issues and ends twenty years from the earliest effective U.S. filing date, or seventeen years from the patent grant. Thus, (A), (C), (D), and (E) are wrong.

34. ANSWER: (C). As stated in MPEP § 707.05(f), “For the purpose of anticipation predicated upon prior knowledge under 35 U.S.C. 102(a), the above noted declassified material may be taken as *prima facie* evidence of such prior knowledge as of its printing date even though such material was classified at that time.” (A) is incorrect. The reference supports the rejection inasmuch as each element of the claimed invention is disclosed in the reference. (B), (D), and (E) are not the most correct. MPEP § 707.05(f).

35. ANSWER: (B). As to (A), (D) and (E), see MPEP §§ 716.07 and 2133.03 (b), page 2100-74 and *In re Epstein*, 32 F.3d 1559, 31 USPQ2d 1817 (Fed. Cir. 1994).

36. ANSWER: (B). (A) is wrong because MPEP § 708.02, IV, recites, “An application may be made special upon filing a petition including any evidence showing that the applicant is 65 years of age, or more, such as a birth certificate or applicant’s statement. No fee is required with such a petition.” (C), (D), and (E) are wrong because a fee is required with respect to each petition. MPEP § 708.02, II, VII, and X, respectively.

37. ANSWER: (A) is the most correct, being supported by the disclosure, and further limiting Claim 2. 35 U.S.C. § 112, first paragraph; 37 C.F.R. §§ 1.75(b), 1.75(c). (B) is not supported by the specification. 35 U.S.C. § 112, first paragraph. (C) is incorrect because it is identical to, and

does not differ substantially from Claim 3. MPEP § 706.03(k). (D) and (E) are incorrect because they are not supported by the disclosure in the specification. 35 U.S.C. § 112, first paragraph. Also, (D) is an improper multiple dependent claims because it depends on claims in the conjunctive (“and”), as opposed to the alternative (e.g., “or”). 37 C.F.R. 1.75(c); MPEP § 608.01(n), section I, subsection B, part 1. (E) is also an improper multiple dependent claim because it does not refer to a preceding claim. 37 C.F.R. 1.75(c); MPEP § 608.01(n), section I, subsection B, part 2.

38. ANSWER: (A). *Hester v. Stein*, 46 USPQ2d 1641 (Fed. Cir. 1998). (B) is wrong because arguments alone can cause a surrender of subject matter that may not be recaptured in reissue. *Id.* (C) is wrong because, even if a declaration from Roberts is needed to help establish error, the reissue application will receive a filing date without an oath or declaration. See, e.g., 37 C.F.R. § 1.53(f), MPEP § 1403. (D) is not correct because, although the recapture rule and prosecution history estoppel are similar, prosecution history estoppel relates to efforts by a patentee to expand the effective scope of an issued patent through the doctrine of equivalents. *Hester*. (E) is incorrect because “late claiming” was long ago discredited, particularly in the context of reissue applications. See, e.g., *Correge v. Murphy*, 217 USPQ 753 (Fed. Cir. 1983); *Railroad Dynamics, Inc. v. A. Stucki Company*, 220 USPQ 929.

39. ANSWER: (C) is the most correct. See MPEP 1412.02 Recapture. As to (A), recapture occurs when the claim is broadened. Adding a limitation would narrow the claim. As to (B), recapture does not apply to continuations. As to (D), the two-year date relates to broadening reissue applications, not to the issue of recapture. 35 U.S.C. 251 prescribes a 2-year limit for filing applications for broadening reissues: “No reissue patent shall be granted enlarging the scope of the original patent unless applied for within two years from the grant of the original patent.” (E) is incorrect because a (C) is correct.

40. ANSWER: (E). Since independent claims are the broadest claims in an application, and dependent claims depend on the independent claims, broadening of a dependent claim can not broaden the scope of invention. This logical deduction was also noted in *In re Portola Packaging Inc.*, 110 F.3d 786, 42 USPQ2d 1295 (Fed. Cir.1997). As to (A) and (B), continuation applications may be filed before application pendency terminates. Moreover, since narrower claims may be patentable, even though the broader claims are determined to be unpatentable, the narrower claims are not barred. As to (C), obviousness-type double patenting prevents several patents from being based upon obvious improvements. As to (D), failure to claim a feature not found in a genus is of no consequence.

41. ANSWER: (E). 35 U.S.C. §§ 116 and 117; 37 C.F.R. § 1.47. (B) is incorrect because the assignment did not relieve each live inventor from the statutory requirements (35 U.S.C. §§ 115, and 116) to sign the declaration, and for the executor or administrator to sign the declaration. (35 U.S.C. § 117). (B) is also incorrect in deleting the names of Bea and Mae as inventors. (D) is incorrect because the deceased inventor is not missing. See MPEP § 409.03(c). Also, Seya has not shown that Mae could not be found or reached after diligent effort, or that Mae had refused to sign the declaration.

42. ANSWER: (E) is the correct answer. (A) is incorrect since admissions, including figures labeled “prior art” may be used. MPEP 2129. (B) is incorrect since canceled matter in the application file of a U.S. patent becomes available as prior art as of the date the application issues into a patent. See MPEP 2127, and *Ex parte Stalego*, 154 USPQ 52, 53 (Bd. App. 1966) cited therein. (C) is incorrect since an abandoned patent application may become evidence of prior art when it has been appropriately disclosed, as, for example, when it is referenced in a publication. See 37 C.F.R. § 1.14(a)(3)(iv); MPEP 2127; and *Lee Pharmaceutical v. Kreps*, 577 F.2d 610, 613, 198 USPQ 601, 605 (9th Cir. 1978) cited in MPEP 2127. (D) is incorrect because multiple reference rejections under 35 U.S.C. § 102 may be used where one reference is used to merely explain a term used in the primary reference. See MPEP 2131.01 and *In re Baxter Travenol Labs.*, 952 F.2d 388, 21 USPQ2d 1281 (Fed. Cir. 1991) cited therein. (E) is correct since the reference is not by “another.”

43. ANSWER: (E). 35 U.S.C. § 135(b) precludes an applicant from copying a claim from a patent that has been issued for more than one year. The Commissioner cannot waive a statutory requirement. Thus, (A) and (B) are wrong. Similarly, (D) is wrong because the examiner does not have discretionary power to accept claims barred by statute. (C) is wrong not only because Jones does not have an issued patent on which to base jurisdiction under 35 U.S.C. § 291, but also because the PTO is not a party to the suit. *In re McGrew*, 120 F.3d 1236, 43 USPQ2d 1632 (Fed. Cir. 1997); MPEP § 2307.

44. ANSWER: (B). See 37 C.F.R. § 10.87. As to (A), practitioner may not limit damages under 37 C.F.R. § 10.78. As to (C), see 37 C.F.R. § 10.89(b)(1). As to (D), see 37 C.F.R. § 10.89(c)(4). As to (E), see 37 C.F.R. § 10.112(a) where client funds advanced for legal services are required to be deposited in a bank account.

45. ANSWER: (B) is correct. MPEP § 2173.05(h). A Markush group is an acceptable form of alternative expression provided the introductory phrase “consisting of,” and the conjunctive “and” are used. (A) and (D) are incorrect because the conjunctive “or” is used. (C) and (D) are incorrect because the introductory phrase “comprising” is used. (E) is incorrect because R must simultaneously be A, B, C, and D, as opposed to being a single member of the group, i.e., no language provides for the selection of one of the members of the group of A, B, C, and D. MPEP § 2173.05(h).

46. ANSWER: (A) is the most correct answer. Hand entry of amendments is no longer permitted. 37 C.F.R. § 1.121(b)(2). Answers (B), (C) and (D) are all correct pursuant to the December 1, 1997, change. 37 C.F.R. §§ 1.121(b)(2)(ii), and 1.121(b)(2)(iii). Answer (E) is also a correct statement. 37 C.F.R. § 1.121(b)(2)(i)(A) and MPEP § 1453, page 1400-37 through 39.

47. ANSWER: (B). Any person at any time may file a request for reexamination. 35 U.S.C. § 302. As to (A) loser may appeal to District Court under 35 U.S.C. § 146. As to (C), there is no prohibition regarding spouses, family members, and other relatives. As to (D) according to 35 U.S.C. § 4, employees are prohibited during the period of their employment and one year thereafter. As to (E), (B) is true.

48. ANSWER: (C). 37 C.F.R. § 1.56; MPEP 2001.01. (A) is incorrect since both the inventor and registered practitioner have a duty to disclose under 37 CFR 1.56(c)(1) & (2). (B) is incorrect since the disclosure must be in writing. (D) is incorrect because the duty does not depend on the likelihood that an examiner would find the art independently. (E) is incorrect since the patent may be relied upon for a rejection under 35 U.S.C. § 102(a) and the patent therefore is material to patentability.

49. ANSWER: (A). 37 C.F.R. § 10.84(b)(2) specifies that a practitioner may refuse to aid or participate in conduct the practitioner believes to be unlawful, even though there is some support for an argument that the conduct is legal. Thus, statement (A) is FALSE. Statement (B) is TRUE. 37 C.F.R. § 10.49. Statement (C) is TRUE. 37 C.F.R. § 10.64(a)(3). Statement (D) is TRUE. 37 C.F.R. § 10.85(b)(1). Statement (E) is TRUE. 37 C.F.R. § 10.68(a)(1).

50. ANSWER: (E). MPEP 2133.03(e)(6) sets forth that while technological, developmental testing is permitted and is not a bar under 35 U.S.C. § 102(b), market testing is not permitted. Choice (A) is incorrect. Since Smith’s activities, as set forth by the facts given in the question, included market testing, choices (B) and (C) are incorrect. (C) is further incorrect since an affidavit under 37 C.F.R. § 1.131 is not applicable to rejections under 35 U.S.C. § 102(b). (D) is incorrect since secondary considerations, such as commercial success, are not applicable rejections under 35 U.S.C. § 102(b).